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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,450	04/10/2004	Peter C. Boylan III	UV-064 Cont.	1337

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EXAMINER	
SALCE, JASON P	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/821,450	BOYLAN ET AL.	
	Examiner	Art Unit	
	Jason P. Salce	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-20 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing (see page 10 of In Re Bilski 88 USPQ2d 1385). The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claimed method including steps of determining and presenting are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 9-12 and 19-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Florin et al. (U.S. Patent No. 5,583,560).

Referring to claim 1, Florin discloses means for determining when a user selects a non-programming program guide option (**see Figures 43-45 and Column 23, Line 45 through Column 24, Line 44 for determining when a user selects a TV shopping application**).

Florin discloses means for presenting an advertisement as part of a program guide screen in the program guide based on which program guide non-programming option is selected (**see Figure 45 and Column 23, Line 45 through Column 24, Line 44 for displaying an advertisement for The Attic at Cacy's after selecting the non-programming program guide option TV Shop channel**).

Referring to claim 2, Florin also discloses means for presenting the advertisement further comprises means for presenting a selectable advertisement (**see Figures 45-46 and Column 23, Line 45 through Column 24, Line 44 for selecting The Attic at Cacy's option**).

Referring to claim 9, Florin discloses determining when a user selects a program guide function button in the program guide (**see screen 180 in Figure 3 transitioning to screen 180 in Figure 45, therefore the program guide of Florin inherently determines when a user selects the TV Shop option to enter screen 180 in Figure 45, otherwise no transition is made (further note Column 23, Lines 62-65)**).

Florin also discloses presenting an advertisement as part of a program guide screen based on which program guide function button is selected (**see Figure 45 for presenting advertisements for various stores in response to the selection of the TV shop option in Figure 43**).

Referring to claim 10, Florin discloses taking a targeted program guide action in the program guide based on which program guide non-programming option is selected (**see Figure 46 for presenting The Attic at Cacy's store in response to the selection of the TV Shop option in Figures 43 or 45 (non-programming option selected)**).

Referring to claims 11-12 and 19-20, see the rejection of claims 1-2 and 19-20, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin et al. (U.S. Patent No. 5,583,560) in view of Shoff et al. (U.S. Patent No. 6,240,555).

Referring to claim 3, Florin also discloses a television distribution facility for distributing television programming to the user television equipment (**see Service Provider 50 in Figure 1 and Column 8, Lines 8-17**) and providing advertisements to the user television equipment (**see Figures 43-50 for providing various advertisements to user television equipment for display on a graphical user interface**).

Florin fails to disclose a video server located in the television distribution facility for providing advertisements containing video to the user television equipment.

Shoff discloses video servers located at the television distribution facility (**see enhanced content server 52 at television headend 22 in Figure 4**) and at another network node for providing advertisements containing video to the user television equipment (**see ISP host 80 in Figure 4 and Column 5, Lines 12-22 for the advertisements containing video and Column 7, Lines 51-60**

for receiving the advertisements from both the ISP 80 and the enhanced content sever 52 at television headend 22).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television distribution system, as taught by Florin, to include the enhanced content servers located at different network nodes, as taught by Shoff, for the purpose of providing a better way of creating and distributing interactive programming (**see Column 2, Lines 51-53 of Shoff**).

Referring to claim 4, Florin also discloses a television distribution facility for distributing television programming to the user television equipment (**see Service Provider 50 in Figure 1 and Column 8, Lines 8-17**) and providing advertisements to the user television equipment (**see Figures 43-50 for providing various advertisements to user television equipment for display on a graphical user interface**). Florin also discloses a plurality of network nodes for use in providing the television programming to the user television equipment (**see Service Provider 50, VCR 56 and Other Audio/Visual Devices 57 that are different network nodes that provide different television programming to user television equipment 58 in Figure 1**).

Florin fails to disclose a video server located in the television distribution facility for providing advertisements containing video to the user television equipment.

Shoff discloses video servers located at the television distribution facility (**see enhanced content server 52 at television headend 22 in Figure 4**) and at another network node for providing advertisements containing video to the user television equipment (**see ISP host 80 in Figure 4 and Column 5, Lines 12-22 for the advertisements containing video and Column 7, Lines 51-60 for receiving the advertisements from both the ISP 80 and the enhanced content sever 52 at television headend 22**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television distribution system, as taught by Florin, to include the enhanced content servers located at different network nodes, as taught by Shoff, for the purpose of providing a better way of creating and distributing interactive programming (**see Column 2, Lines 51-53 of Shoff**).

Referring to claims 13-14, see the rejection of claims 3-4, respectively.

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin et al. (U.S. Patent No. 5,583,560) in view of Knee et al. (U.S. Patent No. 5,589,892).

Referring to claims 5 and 15, Florin discloses all of the limitations of claim 1, as well as a non-programming option including a music option (**see option 313 in Figure 24**), but fails to teach presenting an advertisement related to music as part of a program guide screen when the user selects the music option.

Knee discloses selecting a music program and offering an advertisement to purchase a CD in response to selection of the music program, thereby teaching presenting an advertisement related to music as part of a program guide screen when the user selects the music option (**see Figure 46 and see Column 38, Lines 20-31**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the interactive television system, as taught by Florin, to include the music program and CD advertisement option, as taught by Knee, for the purpose of providing a new vehicle for marketing program-related products (**see Column 38, Lines 31-34**).

Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin et al. (U.S. Patent No. 5,583,560) in view of Schein et al. (U.S. Patent No. 6,002,394).

Referring to claims 6 and 16, Florin discloses all of the limitation in claim 1, as well as a non-programming option being a messages option (**see a MAIL option in Figure 36**), but fails to teach presenting an advertisement related to messages as part of a program guide screen when the user selects the messages option.

Schein discloses presenting an advertisement related to messages as part of a program guide screen when the user selects the messages option (**see Figures 19A-19C and Column 23, Lines 19-36**)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the interactive television system, as taught by Florin, using the messaging functionality, as taught by Schein, for the purpose of allowing a viewer to accept incoming e-mail messages or send outgoing messages to other television viewers **(see Column 23, Lines 20-22)**, thereby allowing television viewers to send and receive e-mail without having to access the viewers' computers.

Claims 7-8 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin et al. (U.S. Patent No. 5,583,560) in view of Miller et al. (U.S. Patent No. 5,585,866).

Referring to claims 7 and 17, Florin discloses all of the limitations of claim 1, but fails to teach that the non-programming option is a parental control option and presenting an advertisement related to a parental control as part of a program guide screen when the user selects the parental control option.

Miller discloses a non-programming option is a parental control option **(see Figure 39 and Column 22, Lines 1-10)** and presenting an advertisement related to a parental control as part of a program guide screen when the user selects the parental control option **(see Figure 39 for displaying a TV Guide advertisement or multiple advertisements related to parental control options the viewer can choose from after the parental control screen in Figure 39 has been selected for display)**.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic program guide with non-programming options, as taught by Florin, to include parental control non-programming options, as taught by Miller, for the purpose of providing a simplified electronic program schedule system that may be more easily implemented, and which is appealing and efficient in operation (**see Column 3, Lines 29-32 of Miller**).

Referring to claims 8 and 18, Florin discloses all of the limitations of claim 1, but fails to teach that the non-programming option is a setup option and presenting an advertisement related to a setup option as part of a program guide screen when the user selects the setup option.

Miller discloses a non-programming option is a setup option (**see Figure 40 and Column 22, Lines 15-41**) and presenting an advertisement related to a setup as part of a program guide screen when the user selects the setup option (**see Figures 40A-40E for displaying a TV Guide advertisement, a letter/mail/message advertisement or multiple advertisements related to setup options the viewer can choose from after the setup screen in Figure 40 has been selected for display**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic program guide with non-programming options, as taught by Florin, to include parental control non-programming options, as taught by Miller, for the purpose of providing a

simplified electronic program schedule system that may be more easily implemented, and which is appealing and efficient in operation (**see Column 3, Lines 29-32 of Miller**).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2421

Jason P Salce
Primary Examiner
Art Unit 2421

March 23, 2009